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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,881	12/09/2003	Masaaki Oka	SCEP 20.778 (100809-00229)	4767
26304 7590 11/12/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER WENDMAGEGN, GIRUMSEW	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 11/12/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/730,881	Applicant(s) OKA, MASA AKI	
	Examiner GIRUMSEW WENDMAGEGN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 6, 10, 14, 18, 22, 26, 30, 34, 38, 42, 46, 50, 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/9/03; 8/11/04; 8/11/05; 5/9/06; 1/3/07; 9/2/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 1,3-5,7-9,11-13,15-17,19-21,23-25,27-29,31-33,35-37,39-41,43-45,47-49,51-53 and 55-58.

DETAILED ACTION

Election/Restrictions

Claim 1, 3-5, 7-9, 11-13, 15-17, 19-21, 23-25, 27-29, 31-33, 35-37, 39-41, 43-45, 47-49, 51-53, 55-58 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 42, 46 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 42, 46 is drawn to a “program” *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2, 6, 10, 14, 18, 22, 26, 30, 34, 38, 42, 46, 50, 54 is rejected under 35

U.S.C. 103(a) as being unpatentable over Nagishi et al (Patent No 7,269,839) , Chang et al (Patent No US 6,735,253) further in view of Hori et al (Pub No US 2003/0086692).

Regarding claim 2, 10, 42 , 50, Nagishi et al (hereinafter Nagishi) teaches an image editing apparatus, including: an image input unit which inputs original image data to be edited (see figure 3 element 2) ; a first data selector which generates moving image data, constituted by image frames having a predetermined amount of information, for use with normal reproduction, from the original image data (see figure 3 element 41 and paragraph 0064); a second data selector which generates moving image data for special reproduction, for a predetermined section of the moving image data for normal reproduction (see figure 3 element 41 and paragraph 0064) but does not teach the moving image data for special reproduction are constituted by image frames which have the equal composition to images within the frame images that constitute the moving image data for normal reproduction and which have a different amount of information from the images that constitute the moving image for normal reproduction. However Chang et al (hereinafter Chang) teaches image frames which

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have the equal composition to images within the frame images that constitute the moving image data for normal reproduction and which have a different amount of information from the images that constitute the moving image for normal reproduction (see figure5, column11 line7-24).

One of ordinary skill in the art at the time the invention was made would have been motivated to generate special reproduction data as in Chang in to Nagishi because it would decrease the amount of information that needed to be stored.

Both Nagishi and Chang do not teach an identification information generator which generates identification information by which to associate the moving image data for normal reproduction with the moving image data for special reproduction. However Hori et al (hereinafter Hori) teaches generating identification information (by which to associate the moving image data for normal reproduction with the moving image data for special reproduction (see paragraph 0032 video location information).

One of ordinary skill in the art at the time the invention was made would have been motivated to generate identification information (video location information) as in Hori in to Chang because it would make special reproduction of the content effective.

Regarding claim6, Chang teaches an image editing apparatus according to Claim 2, wherein said second data selector generates the moving image data for special reproduction, for a partial area within the image frames constituting the moving image data for normal reproduction (see figure5, column11 line7-24).

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Regarding claim 14, 38, 46, 54, Nagishi teaches an image reproducing apparatus, including: an input unit which inputs signals for use in at least reproducing images (see figure 3 element 2); a first data selector which acquires moving image data, constituted by image frames having a predetermined amount of information, for use with normal reproduction, from the signals inputted in said input unit (see figure 3 element 41 and paragraph 0064); a second data selector which acquires, from the position specified by said position specifying unit, the moving image data for special reproduction (see figure 3 element 41 and paragraph 0064) but does not teach the moving image data for special reproduction are constituted by image frames which have the equal composition to images within the frame images that constitute the moving image data for normal reproduction and which have a different amount of information from the images that constitute the moving image for normal reproduction; and a reproduction unit which reproduces the moving image data for normal reproduction and reproduces, as appropriate, the moving image data for special reproduction). However Chang teaches the moving image data for special reproduction are constituted by image frames which have the equal composition to images within the frame images that constitute the moving image data for normal reproduction and which have a different amount of information from the images that constitute the moving image for normal reproduction (see figure 5, column 11 line 7-24); and a reproduction unit which reproduces the moving image data for normal reproduction and reproduces, as appropriate, the moving image data for special reproduction (see figure 7).

One of ordinary skill in the art at the time the invention was made would have been motivated to generate special reproduction data as in Chang in to Nagishi because it would decrease the amount of information that needed to be stored.

Both Nagishi and Chang do not teach a position specifying unit which acquires, from the inputted signals, information indicative of a relationship between moving image data for special reproduction and the moving image data for normal reproduction, and which specifies from the information a position where the moving image data for special reproduction is present. However Hori teaches a position specifying unit which acquires, from the inputted signals, information indicative of a relationship between moving image data for special reproduction and the moving image data for normal reproduction, and which specifies from the information a position where the moving image data for special reproduction is present (see paragraph 0032 video location information).

One of ordinary skill in the art at the time the invention was made would have been motivated to generate identification information (video location information) as in Hori in to Chang because it would make special reproduction of the content effective.

Regarding claim18, Hori teaches an image reproducing apparatus according to Claim 14, wherein the signals inputted by said input unit do not contain the moving image data for special reproduction, and wherein, after the position has been specified by said position specifying unit, said second data selector acquires the moving image data for special reproduction from the specified position via said input (see figure7 s34-s37).

Regarding claim22, Chang teaches an image reproducing apparatus according to Claim 14, wherein the moving image data for special reproduction are provided for a partial area within image frames that constitute the moving image data for normal reproduction, and wherein, when reproducing the moving image data for special reproduction, said reproduction unit reproduces the thus provided moving image data for special reproduction for the partial area (see figure5, column11 line7-24).

Regarding claim26, Hori teaches an image reproducing apparatus according to Claim 14, wherein the moving mage data for special reproduction are provided for a predetermined section, and wherein said reproduction unit reproduces, as appropriate, the moving image data for special reproduction for the predetermined section (see figure7).

Regarding claim30, 34, Hori teaches an image reproducing apparatus according to Claim 22, wherein said reproduction unit displays the predetermined section where the moving image data for special reproduction are present, in a form recognizable by a user, the image reproducing apparatus further including an instruction receiving unit which receives an instruction to the effect that a user wishes to reproduce the moving image data for special reproduction for the predetermined section displayed (see paragraph 0138-041).

Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, absent unexpected results to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIRUMSEW WENDMAGEGN whose telephone number is (571)270-1118. The examiner can normally be reached on 7:30-5:00, M-F, all Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Girumsew Wendmagegn/
Examiner, Art Unit 2621

/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621

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